



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/676,382

09/30/2003

Corinne Bortolin

16222U-016700US

9159

66945

7590

03/31/2008

TOWNSEND AND TOWNSEND CREW LLP  
TWO EMBARCADERO CENTER, 8TH FLOOR  
SAN FRANCISCO, CA 94111

EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/676,382	<b>Applicant(s)</b> BORTOLIN ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-18 have been examined. Application 10/676,382 (SYSTEM AND APPARATUS FOR LINKING MULTIPLE REWARDS PROGRAMS TO PROMOTE THE PURCHASE OF SPECIFIC PRODUCT MIXES) has a filing date 09/30/2003.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite the limitation "wherein the combination reward is the ability to access the combination reward or another reward at an earlier date". Said limitation is indefinite because it seems to say that a reward can be redeemed prior to the date said reward was offered, which it is impossible.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 9, 10, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Vulkan (US 2003/0212626).

Claims 1 and 10, Vulkan teaches:

A method comprising:

(a) receiving information about a first pre-existing reward program for a first product, wherein the first reward program provides for a first reward (see paragraph 17);

(b) receiving information about a second pre-existing reward program for a second product, wherein the second reward program provides a second reward (see paragraph 17) ; and

(c) providing for a combination reward program that provides a combination reward that is based on at least the purchase of the first product and the second product, and wherein the combination reward is greater than each of the first reward and the second reward (see paragraph 17).

Claims 8 and 17, Vulkan teaches:

providing the combination reward to a customer (see paragraph 17).

Claims 9 and 18, Vulkan teaches:

wherein the first reward program is created by a first merchant and wherein the second reward program is created by a second merchant (see paragraph 92), and

wherein the combination reward program is created by a host organization that is affiliated with the first merchant and the second merchant (see paragraph 92).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3688

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vulkan (US 2003/0212626).

Claims 2 and 11, Vulkan does not expressly teach:

(d) reducing or eliminating the combination reward, if a third product is purchased. However, Official Notice is taken that it is old and well known in the promotion art that the goal of a retailer when offering a reward to a customer is to provide said customer an incentive to purchase a product. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would not offer a reward incentive to a customer that wants to purchase a third product, as said customer would not need an incentive to buy.

Claims 3 and 12, Vulkan does not expressly teach:

receiving information about a third pre-existing reward program for a third product, wherein the third reward program provides a third reward, wherein the combination reward is greater than the third reward. However, Official Notice is taken that it is old and well known in the promotion art that the goal of a retailer when offering a reward to a customer is to provide said customer an incentive to purchase a product. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would offer a customer a greater reward for purchasing a combination of products than for purchasing a third product, if said

Art Unit: 3688

combination reward would give Vulkan a better profit or would eliminate a “surplus” product.

Claims 4 and 13, Vulkan does not expressly teach:

wherein the combination reward program is provided by a host organization, and wherein the host organization also provides a portable consumer device, wherein the combination reward is provided to the consumer after the user uses the portable consumer device, and wherein (a), (b), and (c) are performed using one or more digital computers. However, Official Notice is taken that it is old and well known in the promotion art to use portable consumer devices at point of sale terminal in order to redeem promotions. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would use portable consumer devices in his promotion system as it is old and well known to do so.

Claims 5 and 14, Vulkan does not expressly teach:

wherein the combination reward program is provided by a host organization, and wherein the host organization also provides a portable consumer device, wherein the portable consumer device is a smart card. However, Official Notice is taken that it is old and well known in the promotion art to use smart cards in point of sale terminals in order to redeem promotions. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would use smart cards in point of sale terminal in order to redeem promotions as it is old and well known to do so.

Claims 6 and 15, Vulkan does not expressly teach:

wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward. However, Official Notice is taken that it is old and well known in the promotion art to offer rewards such as coupons that extend the time for redeeming said rewards. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would offer coupon rewards that would extend the time for redeeming promotions, as it is old and well known to do so.

Claims 7 and 16, Vulkan does not expressly teach:

wherein the combination reward is the ability to access the combination reward or another reward at an earlier date. However, Official Notice is taken that it is old and well known in the promotion art that a retailer's goal when offering a customer's reward is to provide said customer an incentive to purchase a product. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would offer a combination reward at an earlier date if said offer would increase sales.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/

Art Unit 3688

March 24, 2008